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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,853	07/28/2003	Michael J. Simons	84108JLT	5816

7590 09/16/2005

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EXAMINER

GILLIAM, BARBARA LEE

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

1.0  
✓

<b>Office Action Summary</b>	<b>Application No.</b> 10/628,853	<b>Applicant(s)</b> SIMONS ET AL.	
	<b>Examiner</b> Barbara L. Gilliam	<b>Art Unit</b> 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 June 2005.  
 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-4 and 6-9 is/are rejected.  
 7) ☒ Claim(s) 5 is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☒ All b) ☐ Some \* c) ☐ None of:  
 1. ☒ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment submitted June 16, 2005 has been entered and fully considered.
2. Claims 1-9 are pending.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bozer et al. (3,574,297) in view of Loccufier et al. (EP 1157828).

a. Bozer et al. teach a process comprising the steps of applying, in a printing design, an alkenylsuccinic acid compound to a surface on a body having a base-reacting, water-insoluble material intimately present at the surface thereof wherein the alkenyl chain has from 8 to 16 carbon atoms. The alkenylsuccinic acid compound is a succinic acid, succinic anhydride, soluble salt of succinic acid or succinyl halide (claims 1-5; column 2, line 52 – column 4, line 7). In the Example, a water solution containing 2.5 percent by weight of n-decenylsuccinic anhydride was prepared and applied to an appropriate surface (column 6, lines 27-35). According to Bozer et al., the alkenylsuccinic acid compound can be applied in any manner that is deemed to be convenient including in any desired solvent, such as water, and from an orifice equipped

apparatus (column 3, lines 27-68), however there is no specific teaching to apply the compound via ink jet. It would have been obvious to one of ordinary skill in the art to apply the alkenylsuccinic acid compound via ink jet based on the teachings of Loccufier et al. (abstract) with reasonable expectation of lowering cost and increasing reliability ([0007]). Further it would have been obvious to adjust the surface tension of the alkenylsuccinic acid solution to be in the range of 20 to 60, preferably from 30 to 50 dynes/cm so that the solution is compatible with conventional ink jet printing systems based on the teachings of Loccufier et al. ([0042]).

### ***Response to Arguments***

5. Applicant's arguments filed June 16, 2005 have been fully considered but they are not persuasive. Applicant argued the oleophilising alkenylsuccinic acid of Bozer et al. does not fall within the definition of the present claims. The Examiner disagrees. Applicant pointed out the alkenyl chain of Bozer is a substituent. In the formulae of present claim 1, R, R' and R" can be -H or -L-B which suggest the R groups are substituents as well. For example if R is -H then it is obvious the -H is off of the carbon in the main chain because it is not chemically possible that the -H atom is part of the carbon main chain. In Bozer et al., an alkenylsuccinic acid is applied to the surface of a body having a base-reacting, water-insoluble material. Succinic acid has the chemical formula  $\text{HOOC-CH}_2\text{-CH}_2\text{-COOH}$  and when substituted with an alkenyl group, R, has the formula  $\text{HOOC-CH}_2\text{-CHR-COOH}$ . The alkenyl chain has 8 to 16 carbon atoms. Therefore the alkenyl chain meets the present limitations for the linking group, L, and the hydrophobic group, B when the alkenyl chain has 9 to 16 carbon atoms.

***Allowable Subject Matter***

6. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter:

8. The specific oleophilising compounds required in claim 5 are not taught in Bozer et al.

***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

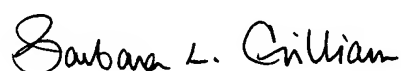
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-

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1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Barbara L. Gilliam  
Primary Examiner  
Art Unit 1752

bg  
September 12, 2005